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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,066	10/12/2001	Kent B. Thudium	16095.002	1828

Anne Dollard  
CHIRON CORPORATION  
Intellectual Property - R440  
P.O. Box 8097  
Emeryville, CA 94662-8097

7590 04/15/2004

EXAMINER

MARVICH, MARIA

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SM.

# **Advisory Action**

**Application No.**

09/977,066

**Applicant(s)**

THUDIUM ET AL.

**Examiner**

Maria B Marvich, PhD

**Art Unit**

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-22.


Claim(s) withdrawn from consideration: 23-31.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: This amendment changes the dependency of claims 2, 5-6, 9-11 and 14-22 from claim 1 to claim 12. Claim 12 recites an expression construct containing the intron A fragment directs transcription equal to or greater than levels achieved by a control expression construct that includes a corresponding intact, full length Intron A sequence as opposed to the control construct recited in claim 1 that completely lacks an intact full length Intron A sequence. The dependent claims 2, 9-11 and 14-18 have not been examined in the context of independent claim 12 and as such raise new issues that would require new consideration. Specifically, as recited by dependent claims 2 and 6, a construct according to claim 12 has not been examined that directs transcription to 2 fold greater than the control construct. Similarly, claims 10 and 11 recite that the expression construct is 90% similar to or the same as the sequence shown in Figure 1C and claims 14-18 recite that the construct contains a coding sequence and promoter which limitations have not been examined in the context of dependency on claim 12.

Claims 5, 12 and 13 change the scope of the invention from a fragment that comprises nucleotides having at least 75% identity to a fragment with 90% sequence identity to contiguous sequences found in Figure 1A and as such raises new issues that would require new consideration.

Continuation of 5. does NOT place the application in condition for allowance because: the applicant's arguments are moot in view of the non-entry of the after final amendment.

  
GERRY LEFFERS  
PRIMARY EXAMINER